

Attorney Docket No.: **WSTR-0017K**  
Inventors: **Gerhard and Otvos**  
Serial No.: **10/541,771**  
Filing Date: **November 30, 2005**  
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#### **REMARKS**

Claims 1-15 are pending in the instant application. Claims 1-15 have been rejected. Claim 1 has been amended. No new matter has been added by this amendment. Reconsideration is respectfully requested in light of the following remarks.

#### **I. Rejection of the Claims Under 35 U.S.C. §102**

The rejection of claims 1-3 under 35 U.S.C. 102(b) as being anticipated by Kragol et al. (2001) has been maintained. It is suggested that Scheme 1, constructs 2 and 7, anticipate the invention. The Examiner suggests that the second Lys-M2- $\beta$ -alanine of the construct fits within the scope of "any amino acid" for R<sub>5</sub> and thus anticipates the invention. Applicants respectfully traverse this rejection.

Applicants have amended claim 1, and by dependency claims 2 and 3, to recite that the antigenic agents of the instant invention comprise R<sub>5</sub> that is alanine. Support for this amendment to the claims can be found throughout the specification as filed and is consistent with the election of species made for R<sub>5</sub>. Further, as acknowledged by the Examiner, Kragol et al. fail to teach or suggest the limitation of R<sub>5</sub> as alanine.

Moreover, as discussed in the previous reply (dated June 30, 2008), while constructs 2 and 7 of Kragol et al. have one Lys-Gly repeat with a B-cell determinant attached thereto (*i.e.*, M2), these constructs possess an additional Lys-M2 residue, which is not present in the instant composition. In order for a reference to anticipate a claim, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d

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1913, 1920 (Fed. Cir. 1989). MPEP §2131. Kragol et al. fail to teach or suggest the claimed multiple antigenic agent of amended claim 1, including failing to teach the limitation of R<sub>5</sub> as alanine; therefore, this reference cannot be held to anticipate the present invention. Withdrawal of this rejection is respectfully requested.

## **II. Rejection of the Claims Under 35 U.S.C. §103**

The rejection of claim 4 under 35 U.S.C. 103(a) as being unpatentable over Kragol et al. (2001) has been maintained for reasons of record. Additionally, the rejection of claims 5-15 under 35 U.S.C. 103(a) as being unpatentable over Kragol et al. (2001) as applied to claims 1-4, and in further view of Neiryneck et al. (1999) has been maintained for reasons of record. In both cases, the Examiner suggests that Applicants arguments directed to the deficiencies of Kragol et al. were not convincing since the second Lys-M2-β-alanine of the construct fits within the scope of "any amino acid" for R<sub>5</sub>. Applicants respectfully traverse this rejection.

As discussed above, the claims have been amended to recite that the antigenic agents of the instant invention comprise R<sub>5</sub> that is alanine. Support for this amendment to the claims can be found throughout the specification as filed and is consistent with the election of species made for R<sub>5</sub>. As acknowledged by the Examiner, Kragol et al. fail to teach or suggest the limitation of R<sub>5</sub> as alanine. 35 U.S.C. 103 requires that in order to establish a *prima facie* case of obviousness the cited references must teach or suggest each limitation of the claims. It is also respectfully pointed out that although Kragol et al. may teach a

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genus of R<sub>5</sub> that is an amino acid, the fact that a claimed species, in this case alanine, may be encompassed by the a prior art genus is not sufficient to render a claimed compound obvious (In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994; In re Jones, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992))).

As discussed by the Supreme Court regarding support for rejections under 35 U.S.C. 103, the analysis supporting a rejection must be made explicit (In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). Clearly in the instant case the Examiner has failed to provide any rationale for how a teaching in Kragol et al. of a genus of Lys-M2- $\beta$ -alanine of the construct fits within the scope of "any amino acid" for R<sub>5</sub>. It is only with the specification in hand that one of skill in the art would recognize that a multiple antigenic agent with alanine for R<sub>5</sub> would be useful when designed as claimed.

Accordingly, this reference cannot be held to make obvious the instant invention since the reference fails to teach or suggest the limitations of the claims as amended. Therefore, it is respectfully requested that these rejections under 35 U.S.C. 103(a) be withdrawn.

### **III. Double Patenting**

Claims 1-15 have been suggested to conflict with claims 1-16 of copending Application No. 11/910,025. Claims 1-15 have been provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-16 of the copending application.

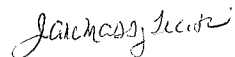
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Applicants respectfully request that this rejection be held in abeyance until allowable subject matter has been identified in copending Application No. 11/910,025.

#### **IV. Conclusion**

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, allowance of the pending claims is earnestly solicited.

Respectfully submitted,



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